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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,039	07/21/2003	Sheila F. Kia	GP-301493 (8540R-000005)	6370
7590 05/19/2005 General Motors Corporation Kathryn A. Marra Legal Staff, Mail Code 482-C23-B21 P.O. Box 300 Detroit, MI 48265-3000			EXAMINER GORR, RACHEL P	
			ART UNIT 1711	PAPER NUMBER
DATE MAILED: 05/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,039

Applicant(s)

KIA ET AL.

Examiner

Rachel F. Gorr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 is indefinite because of the improper use of tradenames in a claim to further limit claim 23 (see MPEP 2173.05(u)).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McBain.

McBain discloses gel coats (col. 10, lines 24-30) comprising acrylate and styrene diluents and a polyester urethane acrylate gel coat resin (see Recipes A and B). In col. 3, line 11, he shows preferring Craynor CN 963 as the resin. Strauss (bottom col. 6 – top col. 7) shows that Craynor 963 comprises a polyester having a number average molecular weight of 1500-2500, an aliphatic polyisocyanate, such as isophorone diisocyanate, and a hydroxyalkyl acrylate. He teaches mole ratios of diisocyanate/hydroxyl acrylate/ polyester diol of about 2/2/1, and he shows the

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polyester made from adipic acid (col. 6, line 57) and hexane diol (col. 6, line 64) and neopentyl glycol (col. 6, line 67). McBain uses pigments in Recipe B, and he discloses difunctional and trifunctional diluents, such as propoxylated glyceryl triacrylate (col. 4, line 43). In recipes A and B, the gel coat resin comprises between 30 and 40 wt. % of the gel coat. When a reference teaches a product that appears to be the same as a product set forth in a product-by-process claim but made by a different process (blending the ester and hydroxyl acrylate before adding the diisocyanate), the burden of proof is shifted to the applicant (see *in re Marosi*, 218 USPQ 289, MPEP 2113).

5. Applicant's arguments filed 4-19-05 have been fully considered but they are not persuasive. The applicants argue that the claims differ from McBain because a different process is used. This is addressed above.

6. Claims 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over McBain in view of Bristowe, Craven, Sadvary and Bollsseau.

7. McBain discloses the gel coat (see above) but differs by reacting the ingredients in a different order, and by not specifying a mixture of benzotriazole and hindered amine light stabilizers. He discloses both stabilizers at the top of col. 5, and uses the hindered amine in his examples.

8. Bristowe discloses three methods for making oligoester acrylate terminated urethanes (bottom col. 5 – top col. 6). He teaches that blending the oligoester and hydroxyl alkyl acrylate before reaction with diisocyanate is preferable because it allows for better control of the exothermic reaction, and minimizes the formation of by-products.

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9. Craven teaches (col. 8, lines 10-30) that a combination of hindered amine and benzotriazole stabilizers exhibit a synergy in acrylate coatings. Sadvary and Boisseau both show, in their coating examples, a combination of Tinuvins 928 and 123.

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of Bristowe in the invention of McBain to minimize the formation of by-products. It would have been obvious to use a combination of benzotriazole and hindered amine stabilizers because Cravens shows the combination better than hindered amine alone, and Sadvary and Boisseau show that the combination is well known on the art.

10. Applicant's arguments filed 4-19-05 have been fully considered but they are not persuasive. The applicants argue that the McBain/Bristowe rejection doesn't provide for the inclusion of a combination of light stabilizers. The above rejection addresses this.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel F. Gorr whose telephone number is 571-272-1072. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R.G.
May 13, 2005


RACHEL GORR
PRIMARY EXAMINER